

REMARKS

INTRODUCTION:

Claims 1 through 7 are pending and under consideration. No new matter is being presented. Reconsideration is respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because no new features or new issues are being raised. Further, no amendments to the claims have been made. The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis). While no amendments are made in this response, we believe that, at a minimum, this response places this case in better form for appeal. Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at pages 2-3, item 3, claims 1, 2, and 4 were rejected under 35 U.S.C. §102 in view of U.S. Patent No. 6,370,149 to Gorman et al. This rejection is traversed and reconsideration is requested.

The Examiner takes the position that Gorman et al. discloses a telecommunication apparatus 180 for initiating and receiving voice and data comprising a first port 190 to connect said apparatus to a circuit switched telecommunication network PSTN, a second port 188 to connect said apparatus to a packet based telecommunication network 40, and a gateway means 74 for establishing a path between said first port and said second port inside said apparatus in response to a request imbedded in an incoming call via said second port. Applicant respectfully submits that this interpretation is incorrect for the reasons set forth below.

a. Port 190 Fails to Connect the Gorman et al. Apparatus to the PSTN

Port 190 is connected to analog telephones, rather than a circuit switched telecommunication network PSTN. Specifically, Gorman et al. states “[a]n RJ-11 jack 190 provides a connection to a cable of the analog telephone (not specifically shown).” Gorman et al., col. 12, lines 3-4. Gorman et al. also states “[a]n analog land-line telephone is coupled to the converter via line 204 connected to RJ-11 jack 190.” Gorman et al., col. 12, lines 37-39.

The connection to PSTN in Fig. 2 and col. 3, lines 41-43, cited by the Examiner, is where the central office is connected to the PSTN. In Fig. 2, Gorman et al.’s subscriber unit, located at the subscriber location 10, is connected to the central office via subscriber line 12. At the other end, subscriber line 12 is connected to port 188 in Fig. 9, rather than port 190 as stated by the Examiner. Thus, a path between the first port 190 and the second port 188 is unable to pass a telephone call from the packet based network to the PSTN.

In further support of this position, Applicant respectfully submits that Gorman et al.’s subscriber apparatus 100 and sub-blocks 180 and 200, shown in Figs. 6-12, have no port or other connection to a PSTN corresponding to “said first port” (252) in the present application. There is no mention of such a connection in the text of the Gorman et al. specification associated with Figs. 6-12. Also, the Tip/Ring converter 125, shown in Figs. 7, 11, and 12, connects to an analog telephone, and not to the PSTN.

Additionally, Applicant notes that a splitter 44, shown in Fig. 3 of Gorman et al., isolates the digital subscriber line connected to port 188 from the PSTN signals on the same twisted pair. Thus, the port 188 is isolated from the PSTN network. Further, there is no indication in the text of Gorman et al. that such a splitter can be arranged inside of the subscriber apparatus 100, or that the PSTN signals from the splitter are processed by or even connected to Gorman et al.’s apparatus.

b. Gorman et al. Lacks Sufficient Control Over Gateway Means 74

Gorman et al.’s apparatus lacks control over gateway means 74 to establish paths between ports on Gorman et al.’s apparatus in response to request from other ports. This is true even if gateway means 74 were connected to those ports, although it is not in the

Gorman et al. apparatus. Gateway means 74, cited by the Examiner, is located in tandem location 30, on the opposite side of the central office 20, as seen from the subscriber 10, where Gorman et al.'s apparatus is located. While gateway means 74 can establish a path between the packet based network and the PSTN, similar to what the gateway means in the present invention does, gateway means 74 can NOT establish paths in response to requests embedded in incoming calls via any port in Gorman et al.'s apparatus. Claims 1, 2, and 4 in the present application thus specify an invention that differs fundamentally from what is disclosed in Gorman et al.

The purpose and function of the subscriber unit disclosed by Gorman et al. is very different from the present invention. Gorman et al.'s device converts a subscriber's analog telephones to fit and connect to a packet based network. To inter-operate with telephones on the PSTN network, Gorman et al. relies on gateways between the two networks owned and operated by the operator of the networks. Gorman et al.'s apparatus only handles the subscriber's own calls. It cannot control the operator's gateway (74) in a remote location, especially not in response to third party calls. In contrast, the present invention allows a third party call to pass from the packet based network to the PSTN inside the user's apparatus.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at page 4, item 5, claim 3 was rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 6,370,149 to Gorman et al. in view of U.S. Patent No. 6,243,377 to Phillips et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Applicant respectfully submits that claim 3 depends indirectly from independent claim 1, and therefore is allowable for substantially the same reasons as independent claim 1, as noted above. Additionally, Phillips et al. fails to disclose the use of a gateway means inside an end user telecommunication apparatus.

In the Office Action at pages 4-5, item 6, claims 5-7 were rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 6,370,149 to Gorman et al. in view of U.S. Patent No.

6,259,691 to Naudas. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Applicant respectfully submits that claims 5-7 depend either directly or indirectly from claim 4, and therefore are allowable for substantially the same reasons as independent claim 4, as noted above. Additionally, Naudas fails to disclose the use of a gateway means inside an end user telecommunication apparatus.

Further, Applicant respectfully submits that the courts have held that the Examiner may not suggest modifying references using the present invention as a template absent a suggestion of the desirability of the modification in the prior art. *In re Fitch*, 23 U.S.P.Q.2d 1780, Fed Cir. 1992. Something in the prior art as a whole must suggest the desirability, and thus, the obviousness, of making the combination. *Alco Standard Corp. v. Tennessee Valley Authority*, 808 F. 2d 1490, 1 U.S.P.Q. 2d 1337 (Fed. Cir. 1986). When a rejection depends on a combination of prior art references, there must be some teaching, suggestion or motivation to combine the references. *In re Geiger*, 815 F.2d 686, 688 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). Thus, since there is no teaching or suggestion of combining Gorman et al. with Phillips et al. or Naudas, it is respectfully submitted that claims 3 and 5-7 are patentable over Gorman et al. in view of either Phillips et al. or Naudas.

The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), limited on other grounds by In re Gartside, 203 F.3d 1305, 53 USPQ2d 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher).

RESPONSE TO EXAMINER'S REMARKS REGARDING IN RE JAPIKSE

On page 5-6, in item 7, of the Office Action, the Examiner rejected Applicant's argument that shifting the location of the gateway means 74 from the tandem location 30 to the apparatus 180 constituted a new inventive concept. In support of this position, the Examiner cited In re Japikse, 86 USPQ 70 (CCPA 1950). Specifically, the Examiner asserts that "shifting location of parts would not constitute any new inventive concept since the operation of the device would not be modified."

Applicant respectfully submits that the Board of Patent Appeals and Interferences has reversed many Examiner rejections based on In re Japikse stating, for example, "[w]e think it is quite clear that Japikse is limited to the facts of the case, i.e., the position of the starting switch is immaterial and, therefore, obvious, since the overall operation of the device would not be affected by such change. In the present case, the Examiner has not established the same could be said for changing the relative locations of Law's throttle and shut-off valves." Appeal No. 1997-0350, Application No. 08/191,384. Further, Applicant notes that the Board of Patent Appeals and Interferences has also reversed many Examiner rejections based on Japikse when an invention shifts location of parts and "is specifically intended to address a disadvantage of [a previous] system. . . ." Appeal No. 1998-2114, Application No. 08/491,286. Thus, Applicant respectfully submits that the USPTO Board of Patent Appeals and Interferences has specifically held that location can constitute an inventive concept, particularly when the location is intended to address a particular problem in previous systems.

In the pending patent application, the invention was specifically created to address disadvantages in having a few concentrated gateways operated by telecommunication companies. Applicant expressly stated the objectives of the present invention in the patent application at page 3, paragraphs 10-12. Specifically, this invention sought "to provide a system for all purpose IP telephony which does not require network gateways in the system," as the prior art is limited by reliance on network gateways in the system. Further, the invention sought "to provide an IP telephony network based on a system of distributed gateways, which are included in IP telephone apparatuses for receiving and initiating calls by users of the system, so the capacity of the system will grow automatically with the number of users", as opposed to the present reliance on telecommunication companies to increase the number of network gateways to increase system capacity. An additional object of the invention is to

"provide a telecommunication apparatus for initiating and receiving voice and data calls, which includes a gateway between circuit switched and packet based telecommunication networks." With the present invention, Applicant sought to specifically address disadvantages in IP telephony based on the limited location of network gateways. Thus, the location of the gateway means and, more specifically, the elimination of the need for network gateway means, is a basic inventive concept of the present invention. As such, In re Japikse is inapplicable to the facts at hand.

In support of Applicant's position, Applicant respectfully submits that shifting the location of gateways from a few concentrated locations operated by telecommunication companies to a large number of local individual gateways presents several advantages over the current state of the art. Shifting the gateways to individual users allows unlimited, immediate expansion and eliminates the bottlenecks experienced when the user base expands more rapidly than the telecommunication companies increase network capacity. Additionally, the reliability and stability of the telecommunications system are improved because the gateways are distributed. If one gateway is damaged, the effect on the total system will be negligible because the load on the gateways is more widely distributed. Finally, the Gateway Telephone 200 presents an economic benefit in that the inclusion of a gateway minimally impacts the cost of the device. In contrast, the network gateways used by telecommunications companies require a physical location, as well as more expensive hardware. Thus, by including gateway means in individual telecommunication apparatuses, the present invention creates both economic and practical advantages over the system presently utilized for IP telephony.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Response, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: David M. Sittler

David M. Pitcher
Registration No. 25,908

1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501